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10/710,852	08/07/2004	Scott Dresden	X-9277	7986
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LERNER GREENBERG STEMER LLP			EXAMINER	
P O BOX 2480			AHMED, AFFAF	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,852	<b>Applicant(s)</b> DRESDEN, SCOTT
	<b>Examiner</b> AFAF AHMED	<b>Art Unit</b> 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 February 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 26 and 30-34 is/are pending in the application.  
 4a) Of the above claim(s) 1-25 and 27-29 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 26 and 30-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection. since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/25/2009 has been entered.
2. Claim 26 has been amended.
3. Claims 1, 13-17 and 27-29 have been canceled.
4. Claims 2-12, 18-25 have been withdrawn.
5. Claims 26 and 30 -34 are currently pending and have been examined.

#### ***Response to Applicant's Arguments***

6. Applicant has properly numbered claims 29 and 30, therefore the objection is withdrawn.
7. Applicant's amendment and arguments filed on 02/25/2009 have been fully considered, but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
9. Claims 26 and 30-34 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).
10. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.
11. Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

14. Claim 33 recites the limitation of: *performing the step of selecting the particular one of the plurality of vendors based on a financial range provided by the potential customer.* the specification teaches "Optional features include where the bidding factor further comprises a preferred vendor status (based on a winning or weighted bid), wherein the bidding factor further comprises a geographical limiter; where the bidding factor further comprises availability of vendor in said category database; where the bidding factor further comprises a financial range provided by the customer; where the bidding factor further comprises a keyword distinction selected by said particular vendor." The specification does not teach *performing the step of selecting the particular one of the plurality of vendors based on a financial range provided by the potential customer.*

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 26 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 26 recites the limitation of: *enabling the potential customer to cause the identification code to be entered into the telecommunications network.* It is unclear what Applicant is referring to by *enabling the potential customer to cause the identification code to be entered into the telecommunications network.* Appropriate correction and/or clarification is required.

18. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should

consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 26, 30, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Thornton, US Pat No: 6,097,792.

As per claim 26, Thornton teaches:

- *placing an advertisement for a product or service on an advertisement medium , the advertisement including a telephonic number for contacting a vendor in order to obtain the product or service ;*
- *enabling a potential customer to place a telephone call by entering the telephonic number into a telecommunications network and enabling the potential customer to cause the identification code to be entered into the telecommunications network ;*

See at least column 7, lines 1-10, column 8, lines 36-52 and Fig 4 with the associated text;

- *obtaining the identification code from the telecommunications network and using the identification code to update a database, which is accessible by the particular one of the plurality of vendors, in order to obtain performance information indicating the effectiveness of the advertisement (see at least column 10, lines 1-16, column 11, lines 14-42 and column 17,lines 19-29);*
- *based on information other than the telephonic number, selecting a particular one of a plurality of vendors and routing the telephone call to the particular one of the plurality of vendors (see at least column 8, lines 36-64);*

#### **Claim 33:**

Thornton teaches the limitations as shown above.

Thornton further teaches:

- *performing the step of selecting the particular one of the plurality of vendors based on a financial range provided by the potential customer (see at least column 8, lines 53-64);*

**Claim 34:**

Thornton teaches the limitations as shown above.

Thornton further teaches:

- *wherein the identification code is a consumer category code associated with the plurality of vendors (see at least column 8, lines 24-64, fig 3 and fig 4 with the associated text);*

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton, US Pat No: 6,097,792

**Claims 31 and 32:**

Thornton teaches the limitations as shown above.

Thornton further teaches:

- *associating the identification code with a plurality of vendors* (see at least column 8, lines 24-64, fig 3 and fig 4 with the associated text);
- *performing the step of selecting the particular one of the plurality of vendors and routing the call to the particular one of the vendors using the identification code* (see at least column 8, lines 56-65);

Thornton does not specifically disclose:

- *using the identification code to identify a geographic location;*

However, Thornton in at least column 15, lines 20-41 discloses an example for routing and redirecting the caller to the closest location to their calling area when placing a call to a business having a multiple locations or stores. Thornton also in at least column 8, lines 56-65 discloses using the ID extension numbers (identification code) to identify features of the advertisements such as homes, cars and /or particular category.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thornton's teaching to include an identification code to identify variety of the advertisements features such as geographic limitation with the motivation of providing users with more pertinent and convenient advertisements.

### ***Conclusion***

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/  
Primary Examiner, Art Unit 3622